04-06-07

AF/1661

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appeal No.:	2007-0317
Serial no.:	09/944,932
Filing date:	08/31/2001
For:	Euphorbia Plant named 'Charam'
Inventor:	Bernard Tickner
Atty. Docket no.:	PH39
Group Art Unit:	1661
Examiner:	Para
Confirmation no.:	2267

RESPONSE TO APPEAL BOARD ORDER UNDER 37 CFR 41.50(d).

In response to the order under 37 CFR 41.50(d) mailed on March 9, 2007, Appellant submits the following response to the issues cited in the order.

I. The public use and availability of a plant variety outside of the United States

1. The public use and availability of a plant variety outside of the United States was determined to not be material to the determination of the patentability of a plant variety in the United States under 35 USC 102(b) in LeGrice (301 F.2d 929 (CCPA 1962). LeGrice disregards public use of a plant variety in a foreign country more than one year prior to the U.S. plant patent filing date as being immaterial to its analysis of the 102(b) rejection based upon printed publications.

2. The court in LeGrice (301 F.2d 929 (CCPA 1962) established a perfectly workable and rational approach for applying the policy and the language of 102(b) to the unique situation of plant patents. LeGrice disregards public use of a plant variety in a foreign country more than one year prior to the U.S. plant patent filing date as being immaterial to its analysis of the 102(b) rejection based upon printed publications.

Both Legrice and the USPTO have stated that both plants and utility patents should have the same 102(b) bars. Legrice confirms that plant patents should receive the same consideration under 102(b) as utility patents.

Appellants believe that the correct standard for a bar under 102(b) for plant patents is a publication more than 1 year prior to the application filing date coupled with enablement within the United States.

II. LeGrice

1. Appellants believe that the holdings of Elsner are in conflict with LeGrice.

2. The court in LeGrice (301 F.2d 929 (CCPA 1962)) established a perfectly workable and rational approach for applying the policy and the language of 102(b) to the unique situation of plant patents. LeGrice disregards public use of a plant variety in a foreign country more than one year prior to the U.S. plant patent filing date as being immaterial to its analysis of the 102(b) rejection based upon printed publications.

Both Legrice and the USPTO have stated that both plants and utility patents should have the same 102(b) bars. The LeGrice court held that "plant descriptions in printed publications of new plant varieties, before they may be used as statutory bars under 35 USC 102(b), must meet the same standards which must be met before a description in a printed publication becomes a bar in non-plant patent cases." (*Legrice*, 301 F.2d at 944)

Legrice confirms that plant patents should receive the same consideration under 102(b) as utility patents. Because the courts and the USPTO have stated that 102(b) should be applied to all patents equally, the holding in Elsner raises the possibility that foreign use of an invention could be a bar in utility patent cases, which is clearly in conflict with 35 USC 102(b).

III. Importation of foreign nursery stock into the United States

1. Foreign asexually propagatable plant material, unlike the information in a printed publication, is not freely accessible to the American public on an unregulated basis. The Plant Quarantine Act of 1912 controls the importation of nursery stock into the United States.

The quarantine act imposes several importation requirements that are applicable to all cultivars of Euphorbia. The importation of plants of 'Charam' into the United States would require a phytosanitary certificate of inspection issued in the country of origin and a written import permit issued by the United States Department of Agriculture (USDA), which permit specifically refers to restricted articles. The import permit is only issued to U.S. citizens or entities. The plant protection authority of the exporting country will not issue a pytosanitary certificate without having a copy of the U.S. import permit. The phytosanitary certificate of inspection certifies that the plants are free from diseases and pest that could cause damage in the United States if imported.

In addition, the USDA may require a period of quarantine to observe the new cultivars for insects and diseases.

These inspections take time in order to ensure the safety of the plants being imported. Therefore, if one skilled in the art did follow the procedures specified by the Plant Quarantine Act of 1912, they would be adding an additional time period before plants were able to be imported into the United States.

IV. The 1998 sale of the claimed plant in the United Kingdom

1. The sale of plants in 1998 in the United Kingdom of Euphorbia Charam were undertaken under the trade name of Euphorbia Redwing. The variety of the present application has been sold under the name Redwing.

It is unknown if one skilled in the art who is interested in reproducing Euphorbia Charam would have known to go to the United Kingdom and purchase plants under the different name of Redwing in order to replicate the plant.

A plant breeder wanting to replicate Charam would logically go out and try to purchase plants of Charam. The plant breeder would not find plants for sale under the name of Charam and therefore would not have any plants to replicate. The sale of Redwing in the United Kingdom does not enable the invention of Charam.

The knowledge or use relied on in a section 102 rejection must be knowledge or use in the United States. Prior knowledge or use which is not present in the United States, even if widespread in a foreign country, cannot be the basis of a rejection under section 102, *In re* Ekenstam, 256 F.2d 321, 118 USPQ 349 (CCPA 1958). There is insufficient evidence to support that it was known in the United States that Charam was being sold as Redwing in the United Kingdom in 1998.

2. The propagation of Euphorbia 'Charam' is enhanced by dipping the cuttings warm water prior to insertion. The method of dipping cuttings in warm water prior to insertion is not disclosed in the section of the RHS Dictionary of Gardening cited by the examiner.

For the extensive reasons advanced above, Appellant respectfully contends that the claim is patentable. Accordingly, reversal of all rejections is courteously solicited.

Respectfully submitted,

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